Attorney Docket # 4925-117

Patent

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Appeal Brief
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: Nguyen, Jennifer T.

Group Art: 2674

In re Application of

Minna PARTANEN et al.

Serial No.: 09/896,963

Filed: June 29, 2001

For: Semi-Transparent Handwriting Recognition UI

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APPEAL BRIEF

SIR:

This is an appeal, pursuant to 37 C.F.R. §1.192(a) from the decision of the Examiner in the above-identified application, as set forth in the Final Office Action dated February 17, 2004, wherein the Examiner finally rejected appellants' claims. The rejected claims are reproduced in Appendix A attached hereto. A Notice of Appeal was filed on April 20, 2004. This Appeal Brief is being submitted in triplicate.

The fee of $330.00 for filing an Appeal Brief (Large Entity) pursuant to 37 C.F.R. §1.17(f) is submitted herewith. Appellants request a two-month Extension of Time of the original shortened statutory response period to file this Appeal Brief. A Petition for the two-month

extension of time is enclosed herewith along with the fee of $420.00 (Large Entity). Any additional fees or charges in connection with this application may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

REAL PARTY IN INTEREST

The assignee, Nokia Corporation, of applicants, Minna PARTANEN and Vesa SIMILA, is the real party of interest in the above-identified U.S. Patent Application.

RELATED APPEALS AND INTERFERENCES

There are no other appeals and/or interferences related to the above-identified application at the present time.

STATUS OF CLAIMS

Claims 28 to 30 and 59-61 have been cancelled. Claims 1-27, 31-58 and 62 have been rejected. Claims 1-27, 31-58 and 62 are on appeal.

STATUS OF AMENDMENTS

The application was filed with claims 1-62, claims 1, 15, 32 and 46 being independent. By the amendment filed June 29, 2001, claims 28 to 30 and 59-61 were canceled, and claims 1, 14, 15, 31, 32, 45, 46 and 62 were amended.

There have been no Amendments filed subsequent to the Final Office Action.

SUMMARY OF THE INVENTION

Appellants' invention is directed to a user interface (claims 1-14) and a method of using a user interface (claims 32-45) in a mobile telephone having a display; and a user input system (claims 15-27 and 31) and a method for using a user input system in a mobile telephone having a display (claims 46-58 and 62). The invention is intended for use with a handwriting recognition system used with the visual display in the mobile telephone (claims 1-14 and 32-45) and with a user input system in which the user input includes at least one manuscript character (claims 15-27 and 31; and 46-58 and 62). The inventive method comprises opening a semi-transparent window in the display and the inventive apparatus comprises means for opening a semi-transparent window in the display.

The semi-transparent window permits a user to view features of a portion of the display over which the semi-transparent window is opened, and has boundaries which define a contrasting area on the display. A screen shot of a semi-transparent window 12 as claimed is shown in Fig. 1. According to the invention, the semi-transparent window permits the use of an overlying window on the display, while permitting the user to both view the portion of the display which underlies the semi-transparent window, and recognize the boundaries of the semi-transparent window.

This feature is neither shown nor suggested in the applied combination of references on which the Examiner premised his rejection.

Additionally, the applied references fail to teach or suggest the use of the devices disclosed therein in a mobile telephone.

ISSUES

The sole issue on this appeal is whether claims 1-27, 31-57 and 62 are patentable under 35 U.S.C. §.103(a) over United States Patent No. 6,088,481 (Okamoto, *et al.*) in view of United States Patent No. 5,559,942 (Gough, *et al.*).

GROUPING OF CLAIMS

All claims stand or fall together. Claims 1, 15, 32 and 46 are independent.

ARGUMENT

The test for obviousness is whether the combined teachings of the references applied by the Examiner would have suggested the claimed invention to one of ordinary skill in the art. *In re Young*, 927 F.2d 588, 18 U.S.P.Q.2d 1089 (Fed. Cir. 1991). Each reference must be evaluated in its entirety, and the prior art must be considered as a whole. *In re Evanega*, 829 F.2d 1110, 4 U.S.P.Q.2d 1249 (Fed. Cir. 1987). Additionally, obviousness must be considered in light of the problems facing the inventor, *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 U.S.P.Q.2d 1321 (Fed. Cir. 1990); and there must be some motivation for making a combination suggested by the Examiner. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988) ("'teachings of references can be combined only if there is some suggestion or incentive to do so.'"); *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) (The Examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

Here, the combination of references suggested by the Examiner fails to teach or suggest the invention as claimed, and there is nothing in the record to support the argument that there existed any motivation in the art to combine the references as suggested by the Examiner. Furthermore, even if made, the combination suggested by the Examiner would not result in the claimed invention.

Okamoto, *et al.* disclose a handwritten character input device allowing input of handwritten characters to an arbitrary application program. According to Okamoto, *et al.*, a window <u>Idsp</u> is opened in an application not otherwise capable of receiving handwritten input (col. Col. 1, lines 8-13). As shown in the Drawings (*see* Figs. 4, *et seq.*), the window <u>Idsp</u> shown in Okamoto, *et al.* is not semi-transparent. This window is expressly described as "transparent" (*see* col. 7, lines 62-64), and is "the same size as the display screen DSP" (*see* col. 7, lines 64-65) so that it has no boundary to define a contrasting area of the display. A separate window WN is shown which overlies a portion of the display DSP, but this window is shown as opaque (*see, e.g.*, Fig. 4A).

Okamoto, *et al.* show yet another window DA (*see* Fig. 4B), in which the user is to place his manuscript input, but this window is completely transparent (*see* col. 8, lines 24-27: "Although the handwriting display area DA is shown by a dotted line in FIGS. 4A to 6, this dotted line cannot be seen on the actual screen.").

The Examiner has conceded that Okamoto, *et al.* do not teach that the window in which manuscript input is to be placed is semi-transparent with boundaries which define a contrasting area of the display (*see* p. 2, final paragraph, of the Final Rejection). In fact, Okamoto, *et al.* expressly teach either that a window on the display is opaque (*e.g.*, WN), or

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completely transparent (*e.g.*, DA). There is no hint or suggestion that the window could be semi-transparent (*i.e.*, neither opaque nor transparent), so that a portion of the display which underlies the window can be viewed, while still having boundaries visible to the user.

This is important, for example, because if the window in which the manuscript input is to be placed is not visible, and makes up only a portion of the display, it would not be possible to guarantee that a user could place the input in the correct position on the display.

Furthermore, Okamoto, *et al.* fail to teach or suggest that the device with which the window is used is a mobile telephone. Okamoto, *et al.*, instead expressly describe the device as a "general computer" (*see* col. 1, line 19, *see, also* col. 6, lines 35-51). Okamoto, *et al.* neither teach nor suggest that the invention may be used in a mobile telephone, and, given their express teachings that the invention uses the various peripherals utilized by a computer (*see* col. 6, lines 40-45), teach away from using the disclosed device with any other type of electronic device, including a mobile telephone. The difficulties faced by one of ordinary skill in the art of mobile telephones are different that those faced by those skilled in the art of computers, since mobile telephones traditionally have had only limited forms of user input (*i.e.*, a keypad), which do not lend themselves well to free-form manuscript input. There is also no motivation shown in the Okamoto, *et al.* patent for combining it with any other reference, and particularly for using the teachings thereof in a mobile telephone.

The Gough, *et al.* reference does not overcome the shortcomings of the Okamoto, *et al.*, patent. Gough, *et al.* teach a method and apparatus for providing a note for an application program in a personal computer. The note is a translucent note slip 76 through which words and characters of underlying text 50 can be viewed (*see,* col. 8, lines 36-37). Gough, *et al.* do not

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teach the use of these windows in mobile telephones, however, and there is nothing in the record to suggest any motivation to combine the teachings of Gough, *et al.* with those of Okamoto, *et al.*

The Examiner has taken the position that it would be obvious to put the translucent windows from the personal computer taught by Gough, *et al.*, in the personal computer taught by Okamoto, *et al.*, and the result would be the use of a semi-transparent window in a mobile telephone. Neither reference, however, teaches the use or modification of their teachings in a mobile telephone. The Examiner has stated that Gough, *et al.* teach the use of the translucent window thereof in a small, hand-held computer (col. 1, lines 16-34 - *see* p. 3, first line, of the Final Rejection), and that this renders use of that window in a mobile telephone obvious. The Examiner, however, points to no teaching in the applied references to support this conclusion, and to no motivation to modify the teachings of both (computer-centric) references to use them in a different field: mobile telephone.

To make the combination suggested by the Examiner therefore would result in a manuscript input system for use with a computer, not for use with a mobile telephone.

Thus, if made, the combination would not result in the claimed invention.

Furthermore, the Examiner has not provided any basis for the position that it would be possible to make the combination of applied references in any event. The types of windows used by Okamoto, *et al.* (either completely opaque or completely transparent) are inconsistent with the types of windows used by Gough, *et al.* (translucent). There is no teaching in the art that the combination of these references would result in a semi-transparent window, rather than an opaque or completely transparent one.

In the absence of such teachings, therefore, it is improper to "pick and chose among isolated disclosures in the prior art" to create a patchwork device which is neither taught nor suggested by the entirety of the references or of the actual teachings of the prior art as a whole. *In re Fine, id.*

For the foregoing reasons, it is respectfully submitted that the combined teachings of Okamoto, *et al.* and Gough, *et al.* fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in claims. The Final Rejection of claims 1-27, 32-57 and 62 should therefore be reversed.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that appellants' claims are not rendered obvious by the combination of Okamoto, *et al.* and Gough, *et al.* as applied by the Examiner, and are, therefore, patentable over the art of record. Accordingly, the Examiner's rejections should be reversed.

Early and favorable consideration of the pending claims is earnestly solicited.

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Respectfully submitted,
COHEN, PONTANI, LIEBERMAN & PAVANE

By _____
Roger S. Thompson
Reg. No. 29,594
551 Fifth Avenue, Suite 1210
New York, New York 10176
Tel (212) 687-2770

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Dated: August 23, 2004

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APPENDIX

1.   (previously amended) A user interface for a handwriting recognition system used with a visual display having a screen, said interface comprising:

means for opening a semi-transparent window in said display, said semi-transparent window permitting a user to view features of a portion of said display over which said semi-transparent window is opened, said semi-transparent window having boundaries which define a contrasting area on said display;

wherein said visual display is part of a mobile telephone.

2.   (original) The user interface of claim 1, further comprising:

an input device for inputting data from said user;

and wherein said semi-transparent window is opened automatically when said user activates said input device at a point on said screen.

3.   (original) The user interface of claim 2, wherein said semi-transparent window opens in a predetermined size and position relative to said point on said screen.

4.   (original) The user interface of claim 3, further comprising means for permitting said user to alter said size of said semi-transparent window after said semi-transparent window opens.

5.   (original) The user interface of claim 4, further comprising means for automatically increasing said size of said semi-transparent window when said user touches said

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touch-activated screen at a point on said touch-activated screen which is outside said borders of said semi-transparent window after said semi-transparent window has been opened, said increased size of said semi-transparent window including said point on said touch-activated screen which is outside said borders.

6.   (original) The user interface of claim 3, further comprising means for permitting said user to move said semi-transparent window to a new position in said display from said predetermined position after said semi-transparent window has been opened.

7.   (original) The user interface of claim 3, wherein said predetermined size and position are alterable by said user.

8.   (original) The user interface of claim 1, wherein said contrasting area is of a color which is different from a color of said portion of said display over which said semi-transparent window is opened.

9.   (original) The user interface of claim 1, wherein said contrasting area is of a brightness which is different from a brightness of said portion of said display over which said semi-transparent window is opened.

10.   (original) The user interface of claim 2, wherein said opened semi-transparent window closes automatically upon an elapse of a predetermined time interval during which no input by said user occurs.

11.   (original) The user interface of claim 1, wherein said semi-transparent window opens automatically when said device requires entry of information from said user.

12.   (original) The user interface of claim 2, further comprising means for generating a visual representation on said display of movement of said input device implement by said user across said screen.

13.   (original) The user interface of claim 12, in which said means for generating stops generating said visual representation of said movement of said writing implement across said display when a predetermined period of time elapses after cessation of movement of said input device on said display.

14.   (previously amended) The user interface of claim 2, wherein said input device is a touch-activated screen.

15.   (previously amended) A user input system for use with an electronic device, comprising:

an input device;

a visual display having a screen, said screen including means for generating an output signal in response to a signal generated by said input device;

means for opening a semi-transparent window in said display in response to said signal from said input device, said semi-transparent window permitting a user to view features of a

portion of said display over which said semi-transparent window is opened, said semi-transparent window having boundaries which define a contrasting area on said display and being sized to receive input from said input device, said input including at least one manuscript character;

means for recognizing said at least one received manuscript character; and

means for displaying said at least one recognized manuscript character on said visual display;

wherein said electronic device is a mobile telephone.

16.   (original) The user input system of claim 15, wherein said semi-transparent window is opened automatically in response to said input from said input device.

17.   (original) The user input system of claim 16, wherein said semi-transparent window opens in a predetermined size and position relative to a point at which said at least one manuscript character is input.

18.   (original) The user input system of claim 17, further comprising means for permitting said user to alter said size of said semi-transparent window after said semi-transparent window is opened.

19.   (original) The user input system of claim 18, further comprising means for automatically increasing said size of said open semi-transparent window when said at least one manuscript character is input at a point on said screen which is outside said borders of said semi-

transparent window after said semi-transparent window has been opened, said increased size of said semi-transparent window including said point which is outside said borders.

20. (original) The user input system of claim 17, further comprising means for permitting said user to move said semi-transparent window to a new point in said display from said predetermined position after said semi-transparent window has been opened.

21. (original) The user input system of claim 17, wherein said predetermined size and position are alterable by said user.

22. (original) The user input system of claim 15, wherein said contrasting area is of a color which is different from a color of said portion of said display over which said semi-transparent window is opened.

23. (original) The user input system of claim 15, wherein said contrasting area is of a brightness which is different from a brightness of said portion of said display over which said semi-transparent window is opened.

24. (original) The user input system of claim 15, wherein said open semi-transparent window closes automatically upon elapse of a predetermined time interval during which no touching of said touch-activated screen occurs.

25.   (original) The user input system of claim 15, wherein said semi-transparent window opens automatically when said device requires entry of information from said user.

26.   (original) The user input system of claim 15, further comprising means for generating a visual representation on said display of movement of said input device by said user across said screen.

27.   (original) The user input system of claim 26, in which said means for generating stops generating said visual representation of said movement of said input device across said screen when a predetermined period of time elapses after any movement of said input device.

28. to 30.   (cancelled)

31.   (previously amended) The user input system of claim 15, wherein said input device is a touch-activated screen.

32.   (previously amended) In a handwriting recognition system used with a visual display having a screen, a method of providing a user interface, said method comprising:

opening a semi-transparent window in said display, said semi-transparent window permitting a user to view features of a portion of said display over which said semi-transparent window has opened, said semi-transparent window having boundaries which define a contrasting area on said display;

wherein said visual display is in a mobile telephone.

33.   (original) The method of claim 32, wherein said semi-transparent window is opened automatically when said user activates an input device for translating movement of said input device into a graphical representation of said movement on said screen.

34.   (original) The method of claim 33, wherein said semi-transparent window opens in a predetermined size and position relative to a point on said screen at which said user initiates movement of said input device.

35.   (original) The method of claim 32, further comprising means for permitting said user to alter said size of said semi-transparent window after said semi-transparent window has opened.

36.   (original) The method of claim 35, further comprising the step of:

automatically increasing said size of said open semi-transparent window when said user activates said input device at a point on said display which is outside said borders of said semi-transparent window after said semi-transparent window has been opened.

37.   (original) The method of claim 34, further comprising the step of:

permitting said user to move said semi-transparent window to a new position in said display from said predetermined position after said semi-transparent window has opened.

38.   (original) The method of claim 34, wherein said predetermined size and position are alterable by said user.

39.   (original) The method of claim 32, wherein said contrasting area is of a color which is different from a color of said portion of said display over which said semi-transparent window has opened.

40.   (original) The method of claim 32, wherein said contrasting area is of a brightness which is different from a brightness of said portion of said display over which said semi-transparent window has opened.

41.   (original) The method of claim 32, wherein said open semi-transparent window closes automatically upon elapse of a predetermined time interval during which no input from said input device occurs.

42.   (original) The method of claim 32, further comprising the step of:

opening said semi-transparent window automatically when said device requires entry of information from said user.

43.   (original) The method of claim 32, further comprising the step of:

generating a visual representation on said display of movement of said input device by said user.

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44.   (original) The method of claim 43, further comprising the step of:

ceasing generating said visual representation of said movement of said input device when a predetermined period of time elapses after any movement of said input device.

45.   (previously amended) The method of claim 32, wherein said input device is a touch-activated screen.

46.   (previously amended) A method of inputting data to an electronic device, comprising:

displaying information on a visual display having a screen;

generating an output signal in response to movement of an input device;

opening a semi-transparent window in said display in response to said movement of said input device, said semi-transparent window permitting a user to view features of a portion of said display over which said semi-transparent window is open, said semi-transparent window having boundaries which define a contrasting area on said display and being sized to receive an input from said input device, said input including at least one manuscript character;

recognizing said at least one manuscript character; and

displaying the recognized manuscript characters on the visual display;

wherein the electronic device is a mobile telephone.

47.   (original) The method of claim 46, further comprising the step of:

opening said semi-transparent window automatically when said user moves said input device.

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48. (original) The method of claim 46, wherein said semi-transparent window opens in a predetermined size and position relative to a point on said display at which said user commences movement of said input device.

49. (original) The method of claim 46, further comprising the step of:

permitting said user to alter said size of said open semi-transparent window after said semi-transparent window opens.

50. (original) The method of claim 49, further comprising the step of:

automatically increasing said size of said open semi-transparent window when said user touches said touch-activated screen at a point on said display which is outside said borders of said semi-transparent window after said semi-transparent window has been opened.

51. (original) The method of claim 48, further comprising the step of:

permitting said user to move said semi-transparent window to a new position on said display from said predetermined position after said semi-transparent window has opened.

52. (original) The method of claim 48, wherein said predetermined size and position are alterable by said user.

53.   (original) The method of claim 46, wherein said contrasting area is of a color which is different from a color of said portion of said display over which said semi-transparent window has opened.

54.   (original) The method of claim 46, wherein said contrasting area is of a brightness which is different from a brightness of said portion of said display over which said semi-transparent window has opened.

55.   (original) The method of claim 46, further comprising the step of closing said open semi-transparent window automatically upon elapse of a predetermined time interval during which no touching of said touch-activated screen occurs.

56.   (original) The method of claim 46, further comprising the step of:

opening said semi-transparent window automatically when said device requires entry of information.

57.   (original) The method of claim 46, further comprising the step of:

generating a visual representation on said display of movement of said input device.

58.   (original) The method of claim 57, further comprising the step of:

ceasing generating of said visual representation of said movement of said input device when a predetermined period of time elapses after any movement of said input device.

59. to 61. (canceled)

62.   (previously amended) The method of claim 46, wherein said input device is a touch-activated screen.